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| 08/818,771      | 03/14/1997  | MOJTABA MIRASHRAFI   | 002784.P001         | 9980             |

7590 06/02/2004

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EXAMINER

NGUYEN, STEVEN H D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2665

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/818,771

Applicant(s)

MIRASHRAFI ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-9,11,13-19,21-25,29,30,33-39,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-9,11,13-19,21-25,29,30,33-39,42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 11, 13, 16-19, 21, 24, 29-30, 33-35, 39 and 42-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Radziewicz (USP 5854897).

As claims 1, 33-35, 39 and 42-43, Radziewicz discloses receiving by said bridge server (Fig 1, Ref 16) from a client system 14 a request for content targeting a network server 12, and determining by said bridge server, based on said received request and not on the requested content, additional content other than the requested content to be provided to the client system by the network server; and providing by said bridge server said determined additional content or an identifier of said additional content to said client system (See claims 1 or 28 wherein the NPS is a means plus function for performing the claimed invention which is disclosed in the specification such intercepting a request packet from the client to a target and using the IP address, URL to identified the addition content such as telephone number etc from a database of announcement server for transmitting to the client with the requested information) See col. 4, lines 49-57, col. 6, lines 56-64, col. 7, lines 18-54, col. 12, lines 1-55 and col. 14, lines 20 to col. 15, lines 59).

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As claim 2, Radziewicz discloses additional content comprises additional information regarding said network server to said client system (See claims 1 and 28; See col. 4, lines 49-57, col. 6, lines 56-64, col. 7, lines 18-54, col. 12, lines 1-55 and col. 14, lines 20 to col. 15, lines 59).

As claim 3, Radziewicz discloses said providing comprises providing by said bridge server said additional content to said client system without altering the substance of the requested content to be provided by said network server (See claim 6 or 7).

As claim 4, Radziewicz discloses determining comprises checking by said bridge server whether additional content corresponding to said network server exists (See claims 1 and 28, the NSP checks the announcement server for addition information; col. 7, lines 18-54,).

As claim 11, Radziewicz discloses the identifier of the additional content comprises a Uniform Resource Locator (URL) corresponding to the additional content (See claim 23).

As claim 13, Radziewicz discloses marking the received request by the bridge server and returning by the bridge server to the client system, the marked version of the received requested for re-submission by the client system (As claim 12, the announcement window includes a marked version for allowing the client to resubmitted; See col. 12, lines 23-45).

As claims 16-18, Radziewicz discloses said providing comprises returning by the bridge server a Hyper Text Markup Language (HTML) page to the client system, wherein the HTML page includes a marked version of the request for resubmission by the client system; said providing comprises returning by said bridge server a Hypertext Markup Language (HTML) page to the client system, wherein the HTML page includes said identifier of the additional content for the client system to retrieve the additional content; providing comprises returning a

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Hypertext Markup Language (HTML) page to the client system, wherein the HTML page includes the additional content (As claim 12, the announcement window includes a marked version for allowing the client to resubmitted; See col. 12, lines 23-45).

As claim 19, Radziewicz discloses bridge server comprising control logic operative to receive a request for content from a client system targeting a network server, and to check, based on said received request and not on the requested content, whether additional content is to be provided to the client system, in addition to the requested content to be provided to the client system by the network server; and content-adding logic, coupled to the control logic, operative to provide the additional content or an identifier of said additional content to the client system if the additional content is to be provided (See claims 1 or 28 wherein the NPS is a means plus function for performing the claimed invention which is disclosed in the specification such intercepting a request packet from the client to a target and using the IP address, URL to identified the addition content such as telephone number etc from a database of announcement server for transmitting to the client with the requested information; See col. 4, lines 49-57, col. 6, lines 56-64, col. 7, lines 18-54, col. 12, lines 1-55 and col. 14, lines 20 to col. 15, lines 59).

As claim 21, Radziewicz discloses the identifier comprises a Uniform Resource Locators (See claim 23).

As claims 24 and 29-30, Radziewicz discloses receiving by the bridge server a request for content from a client system targeting a network server; and marking up by the bridge server the received request and returning the marked up request to the client system for re-submission and means for transmitting another request for additional content, upon receipt of an identifier of the additional content from said bridge server provided in response to the first transmission of the

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request (See claims 1 or 28 wherein the NPS is a means plus function for performing the claimed invention which is disclosed in the specification such intercepting a request packet from the client to a target and using the IP address, URL to identified the addition content in the markup form from a database of announcement server for transmitting to the client for resubmitted; See col. 4, lines 49-57, col. 6, lines 56-64, col. 7, lines 18-54, col. 12, lines 1-55 and col. 14, lines 20 to col. 15, lines 59).

3. Claims 24 and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudetz (USP 5978773 ).

Hudetz discloses in Fig 1, a client 22 including means for transmitting a request that targets the server 20 to a service provider 22 “bridge server” and means for retransmitting the marked up request after receiving a mark up form which marked up by a bridge server 22 for receiving additional information (Fig 6) See col. 9, lines 5-22;

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6-9, 22 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Radziewicz in view Rondeau (USP 5850433).

As claims 6-9, 22 and 36-38, Radziewicz discloses addition information is telephone number for allowing the client to make a phone call later or web page with the hyper links. However, Radziewicz does not disclose said additional content comprises an option for making a telephone call. In the same field of endeavor, Rondeau discloses a system for allowing a client to make a telephone call between a computer and convention telephone without terminating the connection and dialing the telephone number; said option for making a telephone call is an option allowing a user of the client computer system to make the telephone call without having to provide the destination telephone number by the user; said option for making a telephone call is an option allowing a user of the client system to make the telephone call without terminating a current network communication session of the client system; automatically establishing and facilitating a voice call to a PSTN handset in response to a user of the client system selecting the additional content (See Abstract and the database server returned the marked request to client for resubmitting the requested such as making a telephone call).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of returning the marked request in the form of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Radziewicz' method. The motivation would have been to allow the

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customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

7. Claims 14-15, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over anticipated by Radziewicz/Hudetz in view Gabber (USP 5961593).

As claims 14-15, 23 and 25, Radziewicz or Hudetz do not disclose the claimed invention. However, in the same field of endeavor, Garber discloses receiving by the bridge server, the marked version of the request re-submitted by the client system; removing by the bridge server, the marking from the re-submitted request; and forwarding the request to the network server and the marked version of the request comprises a Uniform Resource Locator (URL) corresponding to the request, appended with additional characters identifying the bridge server as the marking bridge server (Fig 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of removing the mark up requests before forwarding the request to target server as taught by Garber's method into the method and apparatus of Hudetz/Radziewicz. The suggestion/motivation would have been to reduce the cost of consumer access fees.

8. Claims 1, 2, 4, 19, 21, 33, 34, 35, 39 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (USP 5754938) in view of Vance (USP 5822539).

Herz discloses a bridge server "proxy server, S2" for receiving a request for content of a target server "Server S4" which is not targeting the bridge server; determining by said bridge server based on the received request, additional content other than the requested content to be provided to the client system by the network server (col. 39, lines 64 to col. 4, lines 36 wherein



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the addition information is belong to the retrieved information of a server 4). Herz does not disclose a step of determining addition content based on URL of target server. In the same field of endeavor, Vance discloses Vance discloses a object of online service being treated as URL of target server (See col. 4, lines 43-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to apply a step of determining if addition content based on URL of the targeting server as disclosed Vance into Herz's system. The motivation would have been to reduce the delay time and improve the throughput of a server.

9. Claims 3, 11, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Vance as applied to claims 1, 19 and 33 above, and further in view of Van Hoff (USP 5822539).

Herz and Vance do not fully disclose the claimed invention. However, in the same field of endeavor, Van Hoff discloses a step of determining if any addition contents are associated with the remote information server, then selecting an addition content to relay to the user (Fig 2, Ref 120 for determining if any documents are related to the requested information, if yes, selecting the addition information for merging into the document from the server 104); a step of sending an additional content without altering from requested information (It's implicitly shown by Van Hoff because Van Hoff does not disclose a step of altering As claim 3); an addition information comprising hyperlink to identify the additional content information; information being mark or tag by hyperlink such as URL to allow the user to retrieve the addition information (See Fig 4; As claim 11, 17-18 and 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to apply a step of determining if additional content is required for the requested before receiving the content information from the targeting server as disclosed Van Hoff's method and system into the system of Herz and Vance. The motivation would have been to reduce the delay time and improve the throughput of a server.

10. Claims 11, 13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Vance as applied to claims 1, 19 and 33 above, and further in view of Hudetz (USP 5978773).

Herz and Vance do not fully disclose the claimed invention. However, in the same field of endeavor, Hudetz discloses in Fig 1, a client 22 including means for transmitting a request that targets the server 20 to a service provider 22 "bridge server" and means for retransmitting the marked up request after receiving a mark up form which marked up by a bridge server 22 for receiving additional information (Fig 6) See col. 9, lines 5-22;

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to provide a client with a markup page in order to allow client to access the server as disclosed by Hudetz into Vance and Herz. The motivation would have been to reduce the delay time and improve the throughput of a server.

11. Claims 6-9, 22 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz and Vance as applied to claims 1, 19 and 33 above, and further in view of Rondeau (USP 5850433).

Herz and Vance fail to disclose the claim invention. However, in the same field of endeavor, Rondeau discloses the additional content information comprising an option to make a

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phone call by allowing a user to click on the icon (Fig 2, Ref 54) to make a phone call via the network to a PSTN handset (Fig 1, Ref 22) and the addition content such as telephone number must be marked by the access server for returning to the user in a form such as icon or button.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a database server which includes a telephone icon as disclosed by Rondeau into a server's Herz and Vance. The motivation would have been to reduce the amount of time required to place a telephone to one of provider.

12. Claims 14-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz, Hudetz and Vance as applied to claims 1, 19 and 33 above, and further in view Gabber (USP 5961593).

Herz, Hudetz and Vance do not disclose the claimed invention. However, Garber discloses the marked version of the request comprises a Uniform Resource Locator (URL) corresponding to the request, appended with additional characters identifying the bridge server as the marking bridge server and receiving by the bridge server, the marked version of the request re-submitted by the client system; removing by the bridge server, the marking from the re-submitted request; and forwarding the request to the network server (Fig 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of adding a tag to the mark up requests before forwarding to client as taught by Garber's method into the method and apparatus of Herz and Van Hoff. The suggestion/motivation would have been to reduce the cost of consumer access fees.

***Response to Arguments***

13. Applicant's arguments filed 3/23/03 have been fully considered but they are not persuasive.

In response to pages 2 and 4, the applicant states that the claimed invention of Radziewicz does not include the language of the claims of the application. In reply, the claim of Radziewicz discloses means plus function such as a network server program for handling communications with a network terminating device "client" and other devices "computer 12" on the communication network "internet" wherein the program will intercept a request from the client which targets the computer 12, the program extracts and forwards URL or IP address of the computer 12 to the announcement server 30. The announcement server 30 retrieves additional information from its storage and transmits this additional information to the network server program which merges the information of computer 12 and the additional information of the announcement server 30 to the client (See claim 1 and 28). Furthermore, the applicant does not point out the means plus function of Radziewicz is different from the claimed invention of the application.

In response to page 3, the applicant states that Herz and Vance fails to disclose the additional content is determined by the identifier of the target network server. In reply, Herz discloses Herz discloses a server for providing the client with additional information and information of the server (See col. 39, lines 64 to col. 44, lines 36, wherein the user's request or target object x includes the identifier of the server s4). Vance discloses an object is URL (See col. 4, lines 43-62).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Herz discloses a method and system for providing addition information and information from the requested server wherein the addition information is provided by the requested target object of server S4. Vance discloses that an object of the server can be identifier via extension to URL or as resource identifiable in according with URL (See col. 4, lines 43-62).

The motivation would have been to provide the clients using a single client application to access information resources regardless of their location, reduce time consuming when searching the Internet for information and friendly user interface.

In response to page 4, the applicant states that Hudetz fails to discloses request for content of the targeted website. In reply, Hudetz discloses a client computer for sending a request for targeting a network server (the client 12 send a request for access a remote host 24 by using UPC for querying its URL), the service provider intercepting the message and reply a markup request that includes UPC and URL so that the user can resubmitting the request again (See Fig 6).

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***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

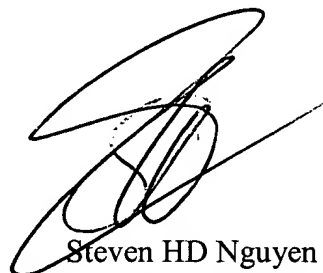
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Steven HD Nguyen', written over a circular stamp or seal.

Steven HD Nguyen  
Primary Examiner  
Art Unit 2665  
5/29/04